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09/368,429	08/05/1999	FUMIHIKO YAMAGUCHI	0950-0110P	5516

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

10

DATE MAILED: 01/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T-D-10

Office Action Summary	Application No. 09/368,429	Applicant(s) YAMAGUCHI ET AL.	
	Examiner Jenna-Leigh Befumo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 3,6-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,10,12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Amendment A, submitted as Paper No. 9 on December 6, 2001, has been entered. Claims 1, 3, 6, 9, and 10 have been amended. Therefore, the pending claims are 1 – 13.
2. Amendment A is sufficient to overcome the objections to the specification and the claims set forth in sections 3 – 5 in the previous Office Action.
3. Amendment A is sufficient to withdraw the 35 USC 112 2nd paragraph rejection set forth in sections 9 – 14 of the previous Office Action. The 35 USC 112 2nd paragraph rejections in sections 8 is maintained below.

Election/Restrictions

4. The Applicant argues that an undue burden would not be present, as shown by the Examiner in section 1 of the previous Office Action. The Applicant states that if the composition is found to be new and unobvious than the method of using the composition would be new and unobvious. However, the Applicant did not elect to search the composition (Group II), instead the Applicant elected to search the carpet comprising a stainproof-treated textile (Group I). That is, the Applicant elected to search the claims drawn to a carpet treated with a composition, and not the composition itself. With respect to the elected invention, the Applicant's argument would be true for a patentably distinct carpet and a method of using said carpet. But the application does not have any claims to such an invention. Thus, the restriction requirement is still FINAL.

Further, with respect to rejoining of the claims under *in re Ochiai*, the Applicant argues that *Ochiai* does not distinguish the method of making from the method of using, and therefore

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the method claims in Group III should be rejoined with the claims in Group I, if the claims in Group I be found allowable. First, it is noted the three groups present in the restriction requirement are Group I: a carpet comprising a stain-proof treatment composition (a final product comprising group II); Group II: a stain-proof treatment composition; and Group III: a method of using the stain-proof treatment (a method of using Group II or a method of making Group I). The Applicant elected to search Group I. As pointed out by the Applicant *Ochiai* states in footnote 6 that “the compounds and their use are but different aspects of, or ways of looking at, the same invention and consequently that invention is capable of being claimed as a new method or process of bonding/priming.” This relationship described by *Ochiai* refers only to Group II, a compound, and Group III, a method of using a compound. Group III is instead the method of making Group I, which is the elected invention, and not a method of using Group I. With respect to the method of making *Ochiai* states further in footnote 6 the following:

... that the method of making compounds is a quite different thing: they may have been made by a process which was new or old, obvious or nonobvious. In this respect, therefore, there is a real difference between a process of making and a process of using and the cases dealing with one involve different problems from the cases dealing with the other.

In other words, the method of making a compound, i.e., Group III, is not necessarily allowable just because the compound, i.e., Group I, is allowable.

Additionally, the Applicant supports the argument that Group III should be rejoined if Group I is found allowable, by citing a section from MPEP 2116.01, stating that *Ochiai* dispels “any distinction between processes of making a product and methods of using a product *with*

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regard to the effect of any product limitation in either type of claim." (Emphasis added.) This section is drawn to interpreting product limitations in method claims based on the teachings on *Ochiai* and not the rejoining of claims based on *Ochiai*. Therefore, this section is not relevant to the issue at hand which is rejoining claims in Group III with Group I, if Group I is found allowable.

5. Newly submitted claim 3 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 3 is drawn to a dirt composition and not a chemically treated carpet.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 3 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

6. Thus, claims 3, 6 – 9 and 11 are withdrawn from consideration as being drawn to non-elected groups.

Claim Rejections - 35 USC § 112

7. Claims 1, 2, 4, 12, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 1, 2, 4, 12, and 13 are indefinite because they fail to set forth the composition or structure of the stainproof treated carpet and only claim properties of the stainproof treated carpet. Claims that merely set forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics are invalid as vague,

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indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future. Ex parte Slob (PO BdApp) 157 USPQ 172.

The Applicant argues that these claims are not indefinite since functional language does not by itself render the claim indefinite (Amendment A, page 9). First, the claim is not indefinite because of functional limitations, but because the claim does not set forth the composition which would meet the physical characteristics desired in an article. Second, while it is agreed that functional language by itself does not make a claim indefinite, it is not agreed (a) that the recited property limitation qualify as functional limitations, and (b) that even if the property limitations were functional limitations they would be definite. MPEP 2173.05(g) states that “a functional limitation is often used in association with an **element, ingredient, or step** of a process to define a **particular capability or purpose** that is served by the recited element ingredient or step,” and “functional limitations must be **evaluated for what it fairly conveys** to a person of ordinary skill in the pertinent art in the context in which it is used.” Hence, the limitations drawn to the stainproof ratio are not functional limitations, since they do not serve to describe a particular capability or purpose of an element or ingredient in the carpet, but the property serves to describe the stainproof-treated carpet as a whole. And even if the recited property was considered to be a functional limitation it would not be definite since it would not convey a definite limitation to a person of ordinary skill in the art. In other words, one of ordinary skill in the art would not know what would produce the recited property based on the claim itself, and thus the claim would be indefinite.

The Applicant also argues that the claims have set forth definite boundaries (Amendment A, page 9). First, as stated by *Slob*, without specific compositions set forth in a claim which would meet the claimed characteristics, the claim covers any conceivable combination of ingredients either presently existing or which might be discovered in the future. *Slob* further states that a claim is too broad and indefinite since it “recites compounds by what it is desired that they do rather than what they are.” Thus, the claims set forth above are indefinite under *Slob* since they only claim the desired properties of the article and fail to set forth the chemical and structural composition which would meet those recited properties. Specifically, the claim is too broad since it is possible for known stain-proof treated carpets to have the recited properties. Just because the recited property is not measured for every known stain-proof composition, does not imply that they would not meet the claimed property and thus the claim is too broad. Also, since it is possible for future stain-proof treated carpets to have the recited property, the claim would read on products which have not been invented yet. Finally, it is possible for compositions to meet the recited limitations which would not be suited for the intended purpose. For example, a lacquer or clear glaze layer could be used to “stainproof” a carpet to meet the desired property since the applied composition, once set, would prevent the carpet from absorbing any stains, however the product would not be suited to the intended purpose. Thus, *Slob* applies to the claims set forth above since the composition which produces the recited property has not been set forth by the limitations in the claim.

Claim Rejections - 35 USC § 102/103

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1, 2, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Blyth et al. (4,592,940).

Blyth et al. disclose a carpet rendered resistant to staining by chemically treating the carpet with a stain-proof composition (abstract). Although Blyth et al. does not explicitly teach the limitations of the recited stainproof ratio, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. a carpet and a stain resistant composition) and in the similar production steps (i.e. applying the stain resistant composition to the carpet) used to produce the stainproof carpet. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed limitations would obviously have been provided by the process disclosed by Blyth et al.

Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

12. Claims 1, 2, and 13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pacifici et al. (5,843,428).

Pacifici et al. disclose finishing compositions used to treat carpets comprising fluorocarbon based repellents and stain blockers (abstract). Although Pacifici et al. does not explicitly teach the limitations of the recited stainproof ratio, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. a carpet and a stain resistant composition) and in the similar production steps (i.e. applying the stain resistant composition to the carpet) used to produce the stainproof carpet. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed limitations would obviously have been provided by the process disclosed by Pacifici et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

Claim Rejections - 35 USC § 103

13. Claims 1, 2, 4, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59150175 A or Kato et al. (5,349,003) in view of Pacifici et al.

These claims are rejected based on the reasons set forth in section 16 of the previous Office Action. Additionally, claims 1, 2, and 13 are added to this rejection since the combination of JP 59150175 A and Pacifici et al. or Kato et al. and Pacifici et al. would produce carpets treated with stainproof compositions. Although the limitations of stainproof ratio are not

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explicitly taught by JP 59150175 A and Pacifici et al. or Kato et al. and Pacifici et al., it is reasonable to presume that said limitations would be met by the combination of the references. Support for said presumption is found in the use of similar materials (i.e. stainproof compositions and carpets) and in the similar production steps (i.e. applying the stainproof composition to a carpet) used to produce the stainproof-treated carpet. The burden is upon the Applicant to prove otherwise. Thus, claims 1, 2, 4, and 13 are rejected.

14. Claims 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59150175 A in view of Pacifici et al. as applied to claim 4 above, and further in view of Kubo et al. (5,883,175) for the reasons of record.

15. Claims 1, 2, 4, 10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amimoto et al. (5,143,991) in view of Kato et al. and Pacifici et al.

These claims are rejected based on the reasons set forth in section 18 of the previous Office Action. Additionally, claims 1, 2, and 13 are added to this rejection since the combination of Amimoto et al. and Pacifici et al. would produce carpets treated with stainproof compositions. Although the limitations of stainproof ratio are not explicitly taught by Amimoto et al. and Pacifici et al., it is reasonable to presume that said limitations would be met by the combination of the references. Support for said presumption is found in the use of similar materials (i.e. stainproof compositions and carpets) and in the similar production steps (i.e. applying the stainproof composition to a carpet) used to produce the stainproof-treated carpet. The burden is upon the Applicant to prove otherwise. Thus, claims 1, 2, 4, 10, and 13 are rejected.

16. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blyth et al. or Pacifici et al.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59150175 A or Kato et al. (5,349,003) in view of Pacifici et al. as applied to claim 1 above.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amimoto et al. in view of Kato et al. and Pacifici et al. as applied to claim 1 above.

The features of Blyth et al., Pacifici et al., JP 59150175 A, Kato et al., and Amimoto et al. have been set forth above. These references fail to teach dyeing the carpet blue. It is well known to dye carpets various colors so that the carpets will be aesthetically pleasing to numerous people and so that the carpets can be matched with already existing décor. Thus, it would have been obvious for one having ordinary skill in the art to choose blue as the color to dye the above carpets since blue is a primary color which can be matched with various other colors and blue is a popular color which is liked by a wide variety of people. Further, it would have been obvious to one having ordinary skill in the art to dye the carpet the recited blue color, since it has been held to be within the general skill of a worker in the art to select a known material (i.e., color) on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Thus, claim 12 is rejected.

Response to Arguments

17. Applicant's arguments filed December 6, 2001, have been fully considered but they are not persuasive. First, the Applicant argues the rejection based on JP 59150175 or Kato et al. in view of Pacifici et al. (Amendment A, page 17). The Applicant states that JP 59150175 (1) includes imine groups which are not part of the present invention, (2) does not mention applying the stainproof composition to carpets, (3) show examples with lowering of strike-through values, and (4) requires stitch staggering-resistance. First, with respect to the imine groups, the

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Applicant does not limit the composition to only the components recited in the claims since the term “comprising” is used to describe the composition. Second, JP 59150175 is not relied on for the teaching of applying the coating to a carpet, but instead is used in combination with Pacifici et al. which teaches applying stainproof treatments to carpets. Thus, the argument is moot since the rejection is not based on JP 59150175 teaching applying the composition to carpets. Third, the examples that the Applicant is referring to are comparative examples and not examples that are representative of the invention taught by JP 59150175. Fourth, according to the English translation of JP 59150175 obtained through the Patent Office (and included with this Office Action) the composition taught provides fabrics with excellent seam shift resistance. Hence, this property is not required by the invention, as argued by the Applicant, but is instead a result of the invention whether it is needed or not. With respect to Kato et al. the Applicant argues that Kato et al. fails to teach producing a carpet with the composition applied thereto. Kato et al. is not relied on for the teaching of applying the coating to a carpet, but instead is used in combination with Pacifici et al. to produce the stainproof-treated carpet. Thus, the argument is moot since the rejection is not based on Kato et al. teaching applying the composition to carpets. With respect to Pacific et al., the Applicant argues that Pacifici et al. does not disclose using a fluoroalkyl-containing compound according to the present invention. However, this point is moot since Pacifici et al. is not relied on for the stainproof composition, but for the teaching of applying stainproof treatments to carpets. Further, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,

208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Thus, the rejections are maintained.

18. The Applicant argues that the rejection based on JP 59150175 in view of Pacific et al. and Kubo et al. should be removed (Amendment A, page 19). The Applicant argues that Kubo et al. does not disclose the present invention. Again, it is noted, that the reference is used in combination with other references to teach the claim invention. The Applicant also argues that there is no indication that the polyfluoroalkyl group containing maleate taught by Kubo et al. is no more preferable than the others shown. However, as set forth in the rejection Kubo et al. discloses that the compound is equivalent with a polyfluoroalkyl group containing (meth)acrylate. And the maleate compound would be less toxic, and thus, it would be preferable. And again the Applicant's arguments with respect to JP 59150175 and Pacifici et al. not teaching all the components of the present invention are moot since the references are used in combination and are not relied on individually for all the components of the present invention. Further, as set forth above, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Thus the rejections are maintained.

19. Finally, the Applicant argues that the rejection based on Amimoto et al. in view of Kato et al. and Pacifici et al. should be removed. The Applicant argues that Amimoto et al. and Pacifici et al. fail to teach the triazine ring-containing component. However, as set forth in the previous Office Action neither reference is relied on to teach the triazine ring-containing component, so the argument is moot. Nor is Kato et al. relied on to individually teach a carpet that is treated with a stainproofing composition. The references are used in combination and not

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individually. Additionally, the Applicant argues that Amimoto et al. teaches desoiling agents for fabrics and not for carpets. However, Amimoto et al. never defines what qualifies as a fabric or further limits the term fabric. Thus, a carpet would qualify as a fabric based on what Amimoto et al. discloses. Further, as set forth above, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Thus the rejections are maintained.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo
January 14, 2002



CHERYL A. JUSKA
PRIMARY EXAMINER